Docket No.: 66703-0015
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Lester K. Chu et al.

Confirmation No.: 2193

Application No.: 10/801,156

Art Unit: 3625

Filed: March 15, 2004

Examiner: N. D. Rosen

For: INFORMATION DISTRIBUTION SYSTEM AND METHOD THAT PROVIDES FOR ENHANCED DISPLAY FORMATS

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted pursuant to 37 C.F.R. § 41.41 and responds to the Examiner's Answer dated March 18, 2008 ("Examiner's Answer"). A Notice of Appeal under 37 CFR § 41.31 was filed on December 18, 2007, and an Appeal Brief was filed on February 19, 2008. This application was filed on March 15, 2004.

ARGUMENT

A. Ground of Rejection No. 1: Claims 1-6, 10, 13-17, 19-24, And 30-32 Are Patentable Under 35 U.S.C. 103(a) Over Littlefield.

1. Littlefield Does Not Teach Or Suggest All The Elements Of Claim 1.

a. "enhanced display fee."

Claim 1 recites in part "the placement of said enhanced listing is not influenced by said enhanced display fee." As Appellants argued in the Appeal Brief (pages 23-25), Littlefield fails to teach or suggest an "enhanced display fee." In the Examiner's Answer, the Examiner cited column 4, lines 24-47 of Littlefield, and stated that "Littlefield clearly and expressly discloses extra fees for including 'non-default items' in listings, the 'non-default items' being enhancements to the listings, such as company logos, having the listing shown in bold, in a particular font, or in a font of a certain size." (Examiner's Answer, page 24.) However, notwithstanding Littlefield's disclosure of "enhancements" to listings with regard to a fee that is associated with an enhanced listing, at most, Littlefield discloses a "yearly subscription fee" and not an "enhanced display fee." (Appeal Brief, pages 23-25.) At least because the Examiner's Answer did not address this argument, and because the Examiner has not shown an "enhanced display fee" in the prior art of record, the rejection of claim 1 should be reversed.

Moreover, with regard to claim 1's recitation that "the placement of said enhanced listing is not influenced by said enhanced display fee," the Examiner admitted that "Littlefield does not state that the placement of the enhanced listing is not influenced by the enhanced display fee." (Examiner's Answer, page 24.) Then, the Examiner maintained that Littlefield allegedly suggests the recitation based on the Examiner's observation that Littlefield "does show unenhanced listings appearing before enhanced listings, and interspersed with them." (Examiner's Answer, page 24.) However, Littlefield's disclosure wholly lacks any suggestion that "the placement of said enhanced listing is not influenced by said enhanced display fee." Indeed, by similar logic to that used by the Examiner, because only the first and fifth listings in each of Figs. 1A and 1B are associated with non-default items, then Littlefield must suggest that non-default items are always listed first and fifth. (Littlefield, Figs. 1A and 1B.) Clearly, such a conclusion is not reasonable or supported by the reference.

As argued in the Appeal Brief, Littlefield's disclosure of default and non-default items interspersed is wholly silent concerning whether the position of those items would have been the same if, for example, all had been either non-default or default items. In fact, Littlefield is totally silent concerning how his default and non-default items are ordered with respect to each other.

Therefore, Littlefield does not in any way suggest that "the placement of said enhanced listing is not influenced by said enhanced display fee." Thus, the Examiner's rejection of claim 1, as well as all claims depending therefrom, should be reversed for any of the foregoing reasons and the claims allowed.

b. "a plurality of priority metrics."

Claim 1 recites "a plurality of priority metrics, wherein each listing in said response is associated with at least one said priority metric." Claim 1 further recites "wherein the placement of each listing is influenced by at least one said priority metric associated with said listing." In the Examiner's Answer, the Examiner states that "[g]iven Littlefield's teaching of different implementations of determining the ranking, the existence of such a plurality of priority metrics, being available for other implementations of Littlefield's invention, is obvious." However, the rejection of claim 1 must be reversed at least because the Examiner has not provided any basis for his conclusion that a disclosure of "different implementations" renders obvious the recited "priority metric."

Indeed, Littlefield states no more than "specific techniques for determining that ranking will vary from implementation to implementation, and the present invention is not limited to any particular ranking technique." (Littlefield, col. 2, lines 15-17.) Littlefield's disclosure that ranking may vary by implementation in no way teaches or suggest "a priority metric," let alone "a plurality of priority metrics," and certainly not "a plurality of priority metrics, wherein each listing in said response is associated with at least one said priority metric." At most, as argued in the Appeal Brief, Littlefield states that listings are ranked according to "user interest." (E.g. Littlefield, col. 2, lines 10-14.) Thus, if anything, Littlefield teaches away from the recited "priority metric."

For at least these additional independent reasons, the Examiner's rejection of claim 1, as well as all claims depending therefrom, should be reversed and the claims allowed.

2. Claim 6 Is Separately Patentable.

Claim 6 depends from claim 1 and recites in part "a per-hit fee amount, wherein said enhanced display fee is included as part of said per-hit fee amount associated with said enhanced listing." In the Examiner's Answer, the Examiner rejected claim 6 because Littlefield allegedly discloses a "per-hit" fee by stating that:

> Instead of or in addition to a subscription fee for associating non-default items with search result listings, search engine provider may also charge click-through fees based on how many times the search engine users actually select a search result listing that is associated with a non-default item."

(Examiner's Answer, page 27, quoting Littlefield, col. 4, lines 10-14.)

However, the Examiner ignored the further recitation in claim 6 of "a per-hit fee amount, wherein said enhanced display fee is included as part of said per-hit fee amount associated with said enhanced listing." (Emphasis added.) The Examiner simply stated that he "wrote nothing that demonstrates Littlefield teaching away from charging a per-hit fee." (Examiner's Answer, page 27.) However, the Examiner's statement fails to address Appellants' arguments. Regardless of whether Littlefield discloses "a per-hit fee," Littlefield fails to teach or suggest "said enhanced display fee is included as part of said per-hit fee amount." As argued in the Appeal Brief, Littlefield discloses a "subscription fee" that may be charged "instead of or in addition to" another fee, which teaches away from an "enhanced display fee" that "is included as part of said per-hit fee." (Appeal Brief, pages 26-27; emphasis added.) Littlefield therefore teaches away from claim 6. In fact, the Examiner admitted in the Final Office Action that Littlefield "makes it obvious for the per-hit fee to be distinct from the enhancement fee." (Appeal Brief, pages 26-27, quoting Final Office Action, page 25.) Thus, the Examiner cannot maintain that Littlefield teaches or suggests an "enhanced display fee" that "is included as part of said per-hit fee." (Emphasis added.)

Thus, for at least these independent reasons, the Examiner's rejection of claim 6, as well as all claims depending therefrom, should be reversed and the claims allowed.

3. Claim 20 Is Separately Patentable.

Claim 20 depends from independent claim 1, and recites in part "wherein said enhanced display fee for said enhanced listing is included in said per-hit fee associated with

said enhanced listing." Thus, claim 20 is separately patentable for reasons similar to those discussed both above and in the Appeal Brief with regard to claims 1 and 6.

Moreover, claim 20 further recites in part, "wherein said listings displayed by said user subsystem are not displayed in an order that is in accordance with said per-hit fee." In the Examiner's Answer, the Examiner argued that "there is no suggestion in Littlefield that the ordering of listings results from the use of click-through fees." As a result, the Examiner concluded that "Littlefield does not at all disclose the use of non-default content to overcome the ordering resulting from use of click-through fees." However, as argued in the Appeal Brief, Littlefield does in fact suggest that listings would be displayed in an order in accordance with a per-hit fee, and the Examiner's conclusion is not in any way supported by Littlefield. (Appeal Brief, pages 27-28.)

Thus, for at least these independent reasons, the Examiner's rejection of claim 20, as well as all claims depending therefrom, should be reversed and the claims allowed.

4. Claim 30 Is Separately Patentable.

Claim 30 depends from claim 1 and recites in part:

> a plurality of fee type attributes, wherein each said enhanced listing in said response is associated with at least one said fee type attribute, and wherein said enhanced display fee associated with said enhanced listing is influenced by said fee type attribute.

In the Examiner's Answer, the Examiner stated that Appellants admitted "that the subscription fee may be based on a variety of factors, including the size and type of the non-default items (enhancements) in search result listings." However, Appellants merely quoted from Littlefield in the Appeal Brief (see page 28), and made no such admission.

Further, as argued in the Appeal Brief, nowhere does Littlefield teach or suggest that click-through fees may be influenced by Littlefield's subscription fee, or vice versa. (Appeal Brief, pages 28-29.) Thus, Littlefield fails to teach or suggest "said enhanced display fee associated with said enhanced listing is influenced by said fee type attribute."

Moreover, in the Appeal Brief, Appellants further argued that "Littlefield in fact teaches away from this claim recitation to the extent that Littlefield discloses differences in

fees solely based on the attributes of the non-default listing, without influence of the fee type attribute." (Appeal Brief, page 29.) In the Examiner's Answer, the Examiner responded:

> the only statement in Littlefield of which Examiner is aware that even remotely approaches this is in column 4, lines 10-14, where Littlefield discloses charging click-through fees based on how many times the search engine users select a search result listing that is associated with a non-default item. That hints at fees based on the attribute of frequency of selection, which could be an attribute of a non-default listing, but, unfortunately for Appellant's case, there is no suggestion of charging fees for nondefault listings; Littlefield is explicit that the fees are based on how often users select a search result listing that is associated with a non-default item. In short: no such disclosure, therefore no teaching away.

(Examiner's Answer, pages 28-29.) However, all Appellants indicated is that, as Littlefield teaches to vary fees based on one approach (attributes of the non-default listings), Littlefield teaches away from varying fees based on another approach (influence of the fee type attribute). In other words, to the extent that there is a difference in fees for different listings in Littlefield, this difference is not due to any influence of a fee type attribute.

For at least the foregoing independent reasons, claim 30 is separately patentable, and therefore the rejection of claim 30 should be reversed.

B. Ground of Rejection No. 2: Claim 8 Is Patentable Under 35 U.S.C. 103(a) Over The Combination Of Littlefield And Helen.

Claim 8 depends from independent claim 1, and thus is patentable at least for the reasons discussed above and in the Appeal Brief with regard to claim 1. Moreover, claim 8 further recites:

> a plurality of responses, including a first response and a second response . . . wherein said first priority metric is associated with said first listing in said first response, and wherein said second priority metric is associated with said first listing in said second response.

Moreover, claim 1 recites "a request." Thus claim 8 recites "a plurality of responses" in the context of "a request." However, the alleged combination of Helen and Littlefield teaches or suggests at most a single response in the context of "a request" and not "a plurality of responses, including a first response and a second response" as recited by Appellants' claim 8. (Emphasis added.)

In the Examiner's Answer, the "Examiner replies, first, that Littlefield, not Helen, was relied upon to disclose first and second responses." (Examiner's Answer, page 29.) However, Littlefield discloses two discrete responses: a first single response for a first request, and a second single response for a second request. Indeed, Littlefield's Fig. 1A shows a response to a search for "oracle," while Fig. 1B shows a response to a search for "palm pilot." (Littlefield, Figs. 1A, 1B.) Thus, Littlefield discloses two queries, each only providing one response, which fails to teach or suggest "a plurality of responses" in the context of "a request."

Moreover, the Examiner continued with regard to Helen that "it is scarcely plausible, that My Deja, which Helen describes, had only been used once, to generate a single response." Indeed, this statement by the Examiner is a clear admission that Helen may only generate a single response and moreover does not address whether Helen teaches a plurality of responses for a request. Helen thus additionally fails to teach or suggest "a plurality of responses, including a first response and a second response" as recited by claim 8, dependent from independent claim 1. Further, as argued in the Appeal Brief, Helen discloses sorting results "by a relevance score, newsgroup, author, subject thread, or date." These purported "priority metrics" all appear within the single set of search results disclosed by Helen, not within "a first response and a second response." (Appeal Brief, page 29.)

For at least these independent reasons, claim 8 is separately patentable, and the Examiner's rejection of claim 8 should be reversed.

C. Ground Of Rejection No. 3: Claim 18 Is Separately Patentable Under 35 U.S.C. 103(a) Over The Combination Of Littlefield And Official Notice.

In the Appeal Brief, Appellants argued that Littlefield fails to teach or suggest, and in fact teaches away from, the recitation in claim 18 that "said detailed view of said enhanced listing requires an affirmative invocation through said user interface before being displayed through said user interface." (Appeal Brief, page 30.) In the Examiner's Answer, the Examiner stated that:

> Littlefield also discloses, "For example, the web page may include controls that allow the subscriber to upload a graphic, an audio file, an applet in the JAVA language, or a movie file" (column 4, lines 38-41). If multiple listings in a set of search results have audio files, movie files, or interactive JAVA

> applets, it is hard to see to how they could all be presented to the user at the same time, without affirmative invocation by the user.

(Examiner's Answer, page 30.) However, this is pure speculation not taught or suggested by the references, and the Examiner's speculation concerning what the references do not teach is an insufficient basis on which to maintain the rejection of claim 18.

Indeed, the Examiner continues to maintain, without any basis, that column 4, lines 38-41 of Littlefield is "strongly suggestive of affirmative invocation by the user being required, 'for the obvious advantage of not assaulting the user with detailed views from multiple enhanced listings in his search results.'" (Examiner's Answer, page 30-31.) However, this interpretation of Littlefield runs counter to the express teaching of Littlefield that "the associated non-default items are delivered whenever the search results include search result listings that correspond to the web page or domain." (Examiner's Answer, page 30, quoting Littlefield col. 5, lines 12-15.) Moreover, the Examiner himself admitted this disclosure "does not seem to call for affirmative invocation by the user." (Id.)

Additionally, were Littlefield to require an affirmative invocation before, for example, playing audio or video files, not only would that run counter to Littlefield's express teaching that "the associated non-default items are delivered whenever the search results include search result listings that correspond to the web page or domain," but moreover, such an affirmative invocation would fatally frustrate the very purpose of Littlefield (see Littlefield col. 3, lines 10-22) by destroying the ability of web page owners to draw user attention to their listings over higher ranked listings. Accordingly, Littlefield fails to teach or suggest, and in fact teaches away from, an "affirmative invocation" approach.

Finally, the Examiner asserted that "Appellants do not address the point that the 'click-to-buy' button of column 6, lines 1-20, might be regarded as providing a detailed view." (Examiner's Answer, page 30.) Here, the Examiner is referring back to the Final Office Action, where the Examiner stated:

> Littlefield arguably does not disclose that the detailed view of the enhanced listing requires an affirmative invocation through said user interface before being displayed through the user interface (unless the "click-to-buy" button of column 6, lines 1-20 is regarded as providing a detailed view)

(Final Office Action, page 12.) However, Appellants did fully address the point at least by their arguments that Littlefield does not teach and in fact teaches away from "said detailed view of said enhanced listing requires an affirmative invocation through said user interface before being displayed through said user interface" as recited by claim 18. (Appeal Brief, pages 31-32.)

Moreover, both in the Final Office Action and also in the Examiner's Answer, the Examiner failed to assert that Littlefield's disclosure of a "click-to-buy button" teaches or suggests even "providing a detailed view," let alone asserting that a "click-to-buy" button reads on "said detailed view of said enhanced listing requires an affirmative invocation through said user interface before being displayed through said user interface." At most, the Examiner speculated concerning an interpretation of how a portion of the reference "might be regarded," without stating that the reference includes any such teaching or suggestion. (Examiner's Answer, page 30.)

Nowhere does Littlefield teach or suggest a "click-to-buy" button that displays a "detailed view of said enhanced listing." Thus, Littlefield's minimal disclosure of a "click-to-buy" again fails to teach or suggest "said detailed view of said enhanced listing requires an affirmative invocation through said user interface before being displayed through said user interface."

For at least the foregoing independent reasons, claim 18 is separately patentable, and therefore the rejection of claim 18 should be reversed.

D. Ground Of Rejection No. 4: Claims 26-29 Are Separately Patentable Under 35 U.S.C. 103(a) Over The Combination Of Littlefield And Talib.

Claim 27 depends from claim 26, which in turn depends from independent claim 1. Thus, claim 27 is patentable at least for the reasons discussed above and in the Appeal Brief with regard to claim 1. Moreover, claim 27 recites in part, "wherein said enhanced listing fee associated with said enhanced listing is influenced by said category attribute." The Examiner noted that this is a limitation of claim 27. (Examiner's Answer, page 32.) Indeed, on pages 31-32 of the Appeal Brief, Appellants argue for the separate patentability of claim 27, and these arguments were and are addressed to the Examiner's rejection of claim 27.

Regarding the recitation of claim 27, the Examiner stated that:

> In fact, Talib discloses that fees associated with advertisements are influenced by the category attribute of a user's request, as taught especially in paragraphs 110 and 111. Talib does not disclose the category attribute influencing, specifically, an enhanced display fee, but Littlefield discloses enhanced display fees.

(Examiner's Answer, page 32.) Thus, not only did the Examiner admit that Talib fails to teach "enhanced display fees," but moreover, the Examiner specifically admitted that Talib fails to disclose "wherein said enhanced display fee associated with said enhanced listing is influenced by said category attribute." The Examiner also admitted that Littlefield fails to disclose categories. (Appeal Brief, page 31, quoting Final Office Action, page 13.) Thus, for at least these reasons the alleged combination of Talib and Littlefield fails to teach or suggest "wherein said enhanced display fee associated with said enhanced listing is influenced by said category attribute."

Further, as argued in the Appeal Brief and as admitted by the Examiner, Talib discloses fees unrelated to the subject matter recited in Littlefield (Appeal Brief, pages 31-32). Therefore, Talib and Littlefield fail to teach or suggest "wherein said enhanced display fee associated with said enhanced listing is influenced by said category attribute" for the further reason that Littlefield and Talib cannot be combined.

Talib discloses charging different set amounts for placing listings into various categories. For instance, Talib relates an example where adding a listing to a "pharmacy" category may cost a business a $1.00 fee, whereas adding the same listing to a "Health Insurance & Information" category may cost a $2.00 fee. (Talib, paragraph [0111].) If a corresponding fee is not paid to add the listing to a category, then the listing is not displayed for the category. (Id.) In contrast, in Littlefield, regardless of whether a fee is paid for display of non-default content, the listing is still included for the search. In at least this way, the subscription fee for non-default content in Littlefield is fundamentally different from any fee contemplated in Talib, and thus the disclosure of Talib with regard to paid listings within categories is not combinable with Littlefield.

In the Examiner's Answer, the Examiner further stated that "[t]here is valid motivation to combine the teachings of these two references, in order to achieve an explicitly

stated advantage," however the Examiner failed to state what that explicit advantage is. (Examiner's Answer, page 32.)

Additionally, as discussed above with regard to independent claim 1, Littlefield fails to teach or suggest an "enhanced display fee." Even assuming for sake of argument that Littlefield does disclose an "enhanced display fee," which it does not, then the alleged combination of Littlefield and Talib would still fail to teach or suggest the recitation of claim 27, at least because the references cannot be combined.

For at least the foregoing independent reasons, claim 27 is separately patentable, and therefore the rejection of claim 27 should be reversed.

E. Ground Of Rejection No. 5: Claim 34 Is Separately Patentable Under 35 U.S.C. 103(a) Over The Combination Of Littlefield, Mangold, And Intasys.

Claim 34 depends from claim 33, which in turn depends from claim 32, which in turn depends from independent claim 1. Thus, claim 34 is patentable at least for the reasons discussed above and in the Appeal Brief with regard to claim 1. Moreover, claim 34 recites in part "a number of hits and a period of time, wherein said number of hits and said period of time influence said variable per-hit fee."

In the Examiner's Answer, the Examiner noted that "Appellants argue against the adequacy of 'Intasys,' without mentioning Mangold." (Examiner's Answer, page 33.) However, the Examiner rejected this claim recitation based on Intasys, having admitted that "[n]either Littlefield nor Mangold discloses a number of hits and period of time, wherein the number of hits and period of time influence the variable per-hit fee." (Appeal Brief, page 32, quoting Final Office Action, page 16.) In fact, Mangold does teach "set[ting] a fixed click through price," and "alter[ing] the amount paid by the advertiser for a click through event based upon the distance between the advertiser and the user." (Mangold, Fig. 11, paragraphs [0036]-[0037].) Nonetheless, this altering of a fixed fee for distance, the Examiner admitted (Final Office Action, page 16), fails to discloses "a number of hits and period of time, wherein the number of hits and period of time influence the variable per-hit fee." (Emphasis added.)

Moreover, in the Examiner's Answer, the Examiner further asserted that Intasys does "teach exactly this, in the sense that a per-hit fee which varies between its full value and zero,

depending on whether there are two click-through from the same IP address within 24 hours, is a variable per-hit fee, broadly defined." (Examiner's Answer, page 33.) However, as argued here and in the Appeal Brief, Intasys teaches no variable fee. In contrast, Intasys teaches a system wherein redundant clicks are filtered out, presumably for reasons such as to improve accuracy or to reduce fraud. (Appeal Brief, pages 32-33.) The only fee charged in Intasys is a constant fee. (Intasys.)

Thus, for at least the foregoing reasons, claim 34 is separately patentable, and the rejection of claim 34 should be reversed.

F. Ground Of Rejection No. 6: Claims 39-43 Are Patentable Under 35 U.S.C. 103(a) Over The Combination Of Littlefield And Official Notice.

1. The Combination Of Littlefield And Official Notice Does Not Teach Or Suggest All Of The Elements Of Claim 39.

Concerning independent claim 39, in the Examiner's Answer, the Examiner stated that he "reiterates his arguments as presented above in regard to claim 1." (Examiner's Answer, page 34.) Thus, for at least the reasons discussed above and also in the Appeal Brief, independent claim 39 is patentable and the Examiner's rejection of independent claim 39, as well as all claims depending therefrom, should be reversed.

2. Claim 42 Is Separately Patentable.

Claim 42 depends from claim 41, which in turn depends from claim 39. Thus, claim 42 is patentable at least for the reasons discussed above and in the Appeal Brief with regard to claim 39. Moreover, claim 42 recites in part, "said advertiser interface providing for the selection of at least one said enhanced attribute and at least one said enhanced display fee." In the Examiner's Answer, the Examiner stated that "Littlefield discloses selection of at least one enhanced attribute, and enhanced display fees for listings with enhanced attributes, implying the selection of the fees in accordance with the selected enhanced attributes." (Examiner's Answer, page 34; emphasis in original.) However, Littlefield includes no such disclosure, and in any event fails to teach or suggest the foregoing recitation of claim 42.

The Examiner stated that:

> Examiner suggests considering the alternatives. Either Littlefield's system lists fees together with enhancements, so that potential subscribers select fees, choosing, for example, to pay a particular fee to have a listing displayed in a special font,

> but not a higher fee to have it displayed in bold, or else fees are not listed with enhancements, so that a subscriber would not know which enhancements cost how much, or carried any charge at all, and would select them only to receive a surprise bill letting him know how much it was costing him in fees he had not selected for the enhancements which he had selected. The second alternative may not be absolutely impossible, but it is unlikely. Subscribers would be reluctant to select enhancements knowing that there would be extra fees, but not knowing how much the fees would be.

(Examiner's Answer, pages 34-35.) However, the Examiner's speculation is not prior art and is not a legitimate basis for rejection. Moreover, the Examiner misrepresented that there are only two possibilities (listing fees together with enhancements, or causing a subscriber to be unaware of incurred fees).

Further, Littlefield completely fails to teach or suggest "said advertiser interface providing for the selection of at least one said enhanced attribute and at least one said enhanced display fee." As argued in the Appeal Brief, Littlefield discloses no selection of fees, only selection of non-default items. (Appeal Brief, page 34, citing Littlefield, col. 4, lines 1-27.) Instead, Littlefield states that "[t]he amount charged by the search engine controller may vary based on a variety of factors." (Id.) Littlefield contains no teaching or suggestion that "said advertiser interface providing for the selection of at least one said enhanced attribute and at least one said enhanced display fee." (Emphasis added.)

Thus, for at least the foregoing reasons, claim 42 is separately patentable, and therefore the rejection of claim 42 should be reversed.

G. Ground Of Rejection No. 7: Claims 44-47, 49, And 51 Are Patentable Under 35 U.S.C. 103(a) Over Littlefield.

1. Littlefield Does Not Teach Or Suggest All Of The Elements Of Claim 44.

Concerning independent claim 44, in the Examiner's Answer, the Examiner stated that he "reiterates the arguments he has set forth above with regard to claim 1." (Examiner's Answer, page 36.) Thus, for at least the reasons discussed above and also in the Appeal Brief, independent claim 44 is patentable and the Examiner's rejection of independent claim 44, as well as all claims depending therefrom, should be reversed.

2. Claim 46 Is Separately Patentable.

Claim 46 depends from claim 45, which in turn depends from claim 44. Thus, claim 46 is patentable at least for the reasons discussed above and in the Appeal Brief with regard to claim 44. Moreover, claim 46 recites in part, "wherein the enhanced display fee is part of the per-hit fee." In the Examiner's Answer, the Examiner stated that:

> Appellants next argue for the separate patentability of claim 46, on the grounds that Littlefield allegedly fails to teach that the enhanced display fee is part of the per-hit fee. Essentially the same point has already been set forth with regard to claim 6, which has similar language, so Examiner reiterates the arguments set forth above for claim 6.

(Examiner's Answer, page 35.) Appellants respectfully indicate that claim 6 and claim 46 include different recitations. Moreover, as argued above and in the Appeal Brief, Littlefield fails to read on the recitation of claim 46 at least because Littlefield discloses two separate fees: "a subscription fee," and "click-through fees based on how many times the search engine users actually select a search result listing that is associated with a non-default item." (Appeal Brief, page 35, quoting Littlefield, col. 4, lines 15-20.) These two separate fees, along with the Examiner's admission "for the per-hit fee to be distinct from the enhancement fee" show the Littlefield in fact teaches away from the recitation of claim 46 that "the enhanced display fee is part of the per-hit fee." (Appeal Brief, page 35.)

Thus, for at least the foregoing reasons, claim 46 is separately patentable, and therefore the rejection of claim 46 should be reversed.

3. Claim 51 Is Separately Patentable.

Claim 51 depends from claim 45, which in turn depends from claim 44. Thus, claim 51 is patentable at least for the reasons discussed above and in the Appeal Brief with regard to claim 44.

Moreover, claim 51 recites in part, "wherein the listings in the response are not displayed in accordance with a per-hit fee that is associated with each of the listings." In the Examiner's Answer, the Examiner stated that the recitation of claim 51 "is essentially parallel to the final clause of claim 1, 'wherein the placement of said enhanced listing is not influenced by said enhanced display fee.'" (Examiner's Answer, pages 35-36.) Thus, the Examiner relied on his previous arguments with regard to claim 1 for this claim recitation of 51. (Id.) Although Appellants do not admit that these two claim recitations are "essentially

parallel," Appellants respectfully submit that claim 51 is separately patentable for at least the reasons discussed above as well as in the Appeal Brief. Thus, the Examiner's rejection of claim 51 should be reversed and the claim allowed.

H. Ground Of Rejection No. 8: Claim 50 Is Separately Patentable Under 35 U.S.C. 103(a) Over The Combination Of Littlefield And Kanell.

Claim 50 depends from claim 45, which in turn depends from claim 44. Thus, claim 50 is patentable at least for the reasons discussed above with regard to claim 44. Moreover, claim 50 recites in part, "the receiving of multiple requests and the display of multiple responses, wherein the same listing appears in an enhanced display format in one response without appearing in an enhanced display format in another response." In the Examiner's Answer, the Examiner admitted that "Kanell, as Appellants state, does not disclose that listings appear with enhancements in some categories but not in other categories." (Examiner's Answer, page 36.) The Examiner then asserted:

> Kanell is suggestive of the claimed feature because Kanell teaches online yellow Pages where a business has to pay to be listed in more than one category, even if it fits in more than one category . . . , and where businesses can pay for such enhancements to their listings as bold face and large box ads that include more information. Examiner maintains that it would therefore have been obvious for the same listing to appear in an enhanced format in one response . . . , but not in another response . . . , for the motivations set forth: "as an obvious consequence of advertisers being unwilling to spend extra money for enhanced advertisements in multiple categories, and listing providers seeking to increase revenues by providing different levels of service, with extra payments required for additional enhancements."

(Id.) However, the Examiner's alleged motivation of "advertisers being unwilling to spend extra money for enhanced advertisements in multiple categories" in itself assumes that "the same listing appears in an enhanced display format in one response without appearing in an enhanced display format in another response." Thus, the Examiner's argument assumes the very thing it sets out to show. Clearly, this is improper hindsight reasoning.

Moreover, Appellants did not dispute that Kanell "describes an actual system," as the Examiner asserted. (Examiner's Answer, page 38.) However, Appellants respectfully disagree that the text of Kanell indicates that Bellsouth's system, as launched, includes all of the features as discussed in Kanell. For example, Kanell states that "the company has started

soliciting for those [enhanced] ads," without indicating whether any ads were actually purchased. (Kanell.) Moreover, Kanell continues that "BellSouth also plans to eventually include links to business sites," meaning that such links are not included in Kanell's system. (Id.; emphasis added.) This view is further reinforced by statements that "the company has no plans to stop distributing the printed versions," and by the BellSouth director of Internet marketing stating that "[w]e really see the two products as complementary to each other," suggesting that the relationship of the Internet listings to the print listings is as of the present time unknown. (Kanell; emphasis added.) Thus, as argued in the Appeal Brief, Kanell merely discloses BellSouth's "hopes" for an online version of its Yellow Pages, without providing any detail on how these "enhancements" may be selectively applied to listings.

Therefore, for at least the foregoing independent reasons, claim 50 is separately patentable, and the rejection of claim 50 should be reversed.

CONCLUSION

In view of the foregoing arguments, Appellants respectfully submit that the pending claims are novel over the cited references. The Examiner's rejections of all pending claims are improper because the prior art of record does not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under Order No. 66703-0015, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: May 9, 2008

Respectfully submitted,

Electronic signature: /Charles A. Bieneman/
Charles A. Bieneman
Registration No.: 51,472
Michael B. Stewart
Registration No.: 36,018
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 25537
Attorneys for Appellant